

Application No. 09/696,765

Attorney Docket No.: 26119-136D US1

REMARKS/ARGUMENTS

In the Patent Office Communication, the Patent Office Examiner noted that claims 1-4, 8-10, 16-18, 24, 26 and 33-35 are pending in the application, that claims 1-4, 8-10, 16-18, 24 and 26 are withdrawn as being directed to separate inventions, and that claims 33-35 are rejected. By this Amendment, no claims have been added or cancelled. Reconsideration is respectfully requested.

Amendment to Claim 33

Claim 33 has been amended to correct a typographical error. Specifically, a comma has been added to claim 33. This amendment adds no new matter.

Rejection of Claims 33-35 under 35 U.S.C. § 103

Claims 33-35 are rejected as being unpatentable over the combination of U.S. Patent 6,721,747 to Lipkin and U.S. Patent 6,389,403 to Dorak et al. Applicant respectfully traverses this rejection.

U.S. Patent 6,721,747 to Lipkin relates to the managing of information in an information system having a server, a client and database for computers, telecommunications and computer network systems. The system generates metadata using an import agent, determines at least one match using a match agent, and dispatches the match or a result associated with the match using a delivery agent. The metadata may be Resource Description Format (RDF) metadata, and/or the match agent may determine the match. The system also provides for managing information using a match template in an information resource system by comparing a first set of metadata with a second set of metadata, dynamically generating a query based on the first set of metadata, and executing the query against the second set of metadata.

U.S. Patent 6,389,403 to Dorak et al. relates to uniquely identifying a customer purchase in an electronic distribution system. The identification method for a digital content player includes receiving first, second and third identifiers, and producing a fourth unique identifier based on mathematical combination of identifiers. The system tracks usage of digital content on user devices. Content sites associate a unique content identifier with the content. Electronic

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stores coupled to a network sell licenses to play digital content data to users. The licenses contain a unique transaction identifier for uniquely identifying the transaction, and the licenses contain a unique item identifier for uniquely identifying at least one item in the transaction. Content players, which receive from the network the licensed content data, are used to play the licensed content data. The content players produce a purchase identifier based upon the mathematical combination of the content identifier, the transaction identifier and the item identifier.

Applicant respectfully disagrees with the Examiner's rejection for at least the following reasons.

a. Lipkin is not related to the claimed invention

Lipkin is concerned with "employ[ing] metadata-based profiles to match information with users" (Lipkin, column 113, lines 56-57). In contrast, claim 33, for example, is limited by "making a first set of personal profiles available," "receiving a second set of personal profiles," "making at least part of the second set of personal profiles available," and "receiving a request to enter into a trusted relationship." **"Because Lipkin only matches a user profile with information resources it is clearly unrelated to the present claimed invention."**

b. The Provisional Application to which Lipkin claims benefit is not related to the claimed invention

Provisional Application No. 60/176,137, filed January 14, 2000, to which Lipkin claims benefit does not show or suggest, for example, "based upon at least part of the first set of personal profiles and at least part of the second set of personal profiles, making at least part of the second set of personal profiles available" as required by claim 33 and asserted by the Examiner to be shown or suggested by Lipkin. Therefore the provisional is not relevant and **does not provide adequate support for exchanging of profiles as part of forming a trusted relationship.** Accordingly, the Lipkin prior art reference is **NOT prior art** to the present application. Therefore, for this reason as well, the rejection should be withdrawn, and such action is respectfully requested.

Thus, **neither of these prior art references, Lipkin and Dorak relate to the invention being claimed, i.e., a networked commercial interaction management method. The Examiner has failed to show any prior art that exchanges profiles, and has also failed to show prior**

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art that shows requesting to enter in trusted relationships, and using the profiles to transition to the trusted relationship.

- c. No Combination of Lipkin and Dorak Shows or Suggests Each of the Limitations of the Rejected Claims, the Examiner Has Not Met the Requirements of 35 U.S.C. § 132 or 37 CFR § 1.104(c), and

Therefore, Has Not Made Out a Prima Facie Case of Obviousness

Generally speaking, Applicants' invention, as defined by independent claims 33-35, is directed towards a networked commercial interaction management method. Independent claim 33 states the following combination of features:

making a first set of personal profiles available, each personal profile in the first set of personal profiles including a first set of first values for a plurality of information fields, the plurality of information fields relating to commercial transactions,

receiving a second set of personal profiles, each personal profile in the second set of personal profiles including a second set of values for the plurality of information fields,

based upon at least part of the first set of personal profiles and at least part of the second set of personal profiles, making at least part of the second set of personal profiles available,

based upon the at least part of the first set of personal profiles and the at least part of the second set of personal profiles, receiving a request to enter into a trusted relationship,

receiving a set of trusted relationship information, and

making the set of trusted relationship information available whereby a commercial transaction is facilitated.

In the Reply to Office Action filed on January 18, 2006 (hereinafter, "Previous Reply"), the Applicant's noted that the Examiner had failed to identify where several limitations of the claims are show or suggested in the Lipkin reference. The current Office Action (mailed April 3, 2005) remains insufficient because the Examiner gave no further indication of what in Lipkin he believes to show or suggest these claim limitations. Therefore, the Applicants respectfully submit that the Examiner has not met the requirements of 37 CFR § 1.104(c), as quoted below, in the rejection of claims 33-35.

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In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (emphasis added)

Specifically, for example, claim 33 recites,

I. based upon at least part of the first set of personal profiles and at least part of the second set of personal profiles, making at least part of the second set of personal profiles available,

II. based upon the at least part of the first set of personal profiles and the at least part of the second set of personal profiles...

In explaining what the Examiner believes to show or suggest these claim limitations, he states only, referring to Lipkin, that "Match Agents and Information Distributor matches metadata and these agents cause web materials to be accessed." However, the claim recites "making at least part of the second set of personal profiles available," "based upon at least part of the first set of personal profiles and at least part of the second set of personal profiles." First, it is unclear which elements of Lipkin the Examiner believes to correspond to which elements of claim 33. Secondly, assuming there is a correlation among the elements, an argument the Applicants rejects, the Examiner does even not indicate that the "web materials" of Lipkin are being made available "based upon at least part of" something else and "at least part of" themselves as claim 33 requires.

Therefore, the Examiner has not "designated as nearly as practicable" what in Lipkin teaches the above listed limitations, as required by 37 CFR § 1.104(c). Since it is unclear what in Lipkin shows or suggest the above listed claim limitations, **the Examiner has not made out a prima facie case of obviousness.** The Applicants have not been notified of "the reasons for such rejection, or objection, or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution" as is required by 35 U.S.C § 132. Therefore, the Applicants respectfully request that the Examiner either withdraw the finality of the rejections and give further indication of what he believes to show or suggest each and every limitation of claim 33 or withdraw the rejections altogether.

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In addition, claims 34-35 are also asserted to be patentably distinguishable over Lipkin and/or Dorak when each claim is interpreted as a whole. Withdrawal of the rejection for these claims as well is respectfully requested. Again, in the Previous Reply, the Applicants noted specific claim limitations that are not shown or suggested in either Lipkin or Dorak.

For example, claim 34 recites, in combination:

I. "making a set of personal profiles available, each personal profile in the set of personal profiles including a first set of first values for a plurality of information fields, the plurality of information fields relating to commercial transactions."

II. "based upon the at least part of the set of personal profiles, receiving a request to enter into a trusted relationship, receiving a set of trusted relationship information, and sending the set of trusted relationship information in order to facilitate a commercial transaction."

As explained above, neither Lipkin nor Dorak show or suggest these features, in combination with the remaining elements of the claims. Withdrawal of the rejection of claim 34 is also respectfully requested.

In addition, and as noted in the Previous Reply, claim 35 recites, in combination:

I. "providing a network adapted to be used in a set of future commercial transactions, making a set of personal profiles available, the set of personal profiles relating to a set of previous commercial transactions."

II. "based upon the at least part of the set of personal profiles, receiving a request to enter into a trusted relationship, receiving a set of trusted relationship information, and sending the set of trusted relationship information in order to facilitate at least one commercial transaction in the set of future commercial transaction."

As explained above, neither Lipkin nor Dorak show or suggest these features, in combination with the remaining elements of the claims. Withdrawal of the rejection of claim 35 is also respectfully requested.

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CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, Applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as

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clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary

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skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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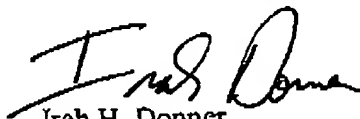
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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